REMARKS

Minor changes have been made to the specification. Claims 1, 9 and 17 are amended and claims 1-24 remain in the application. Re-examination and reconsideration of the application, as amended, are requested.

Claims 1, 6, 8, 9, 13, 14 and 16 are rejected under 35 USC 102(b) as being anticipated by Porzilli (U.S. 5,327,985).

Applicant traverses this rejection on the grounds that this reference is defective in supporting a rejection under 35 USC 102 (b).

Independent claims 1 and 9 include:

1. A speaker apparatus comprising:

a speaker; and

an acoustic box connected to the speaker, the box having a sound reflecting distal wall including a plurality of stepped portions of variable distances from the speaker, each stepped portion being a different distance from the speaker than each other stepped portion.

9. A computer chassis comprising:

a chassis wall;

a speaker mounted on the chassis wall; and

an acoustic box connected to the speaker, the box having a sound reflecting distal wall including a plurality of stepped portions, each stepped portion being of a different distance from the speaker than each other stepped portion, and each stepped portion being substantially parallel to the speaker.

The PTO provides in MPEP § 2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Porzilli* patent must contain all of the claimed elements of claims 1 and 9. However, the claimed stepped portions are not shown or taught in the *Porzilli* patent. Therefore, the rejection is unsupported by the art and should be withdrawn.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, independent claims 1 and 9 are submitted to be allowable.

Claims 2-5, 7, 10-12, 15 and 17-24 are rejected under 35 U.S.C. §103 as being unpatentable over *Porzilli* in view of *Mitchell* (U.S. 5,091,791). Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness.

Independent claim 17 includes:

17. (Amended) A computer system comprising:
    a chassis;
    a microprocessor mounted in the chassis;
    an input coupled to provide input to the microprocessor;
    a storage coupled to the microprocessor;
    a speaker mounted on the chassis; and

an acoustic box connected to the speaker, the box having a sound reflecting distal wall including a plurality of stepped portions of variable distances from the speaker, each stepped portion being substantially parallel to each other stepped portion.

As the PTO recognizes in MPEP § 2142:

> ...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness...the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.... The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because neither the *Porzilli* patent nor the *Mitchell* patent teaches or even suggests the desirability of the combination. Moreover, neither patent provides any incentive or motivation supporting the desirability of the combination.

The MPEP § 2143.01 provides:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. § 103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Monteffore Hospital, 732 F.2d 15 72, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claim invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle

within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

Therefore, independent claims 1, 9 and 17 and the claims dependent therefrom are submitted to be allowable.

No new matter is added by the amendments herein.

In view of the above, it is respectfully submitted that remaining claims 1-24 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,

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2837

PATENT / DO NO. 16356.648 (DC-03060)
Customer No. 000027683

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: Rehmann, Mark L. §
Serial No.: 09/921,081 § Group Art Unit: 2837
Filed: August 2, 2001 § Examiner: Lockett, Kimberly R.
For: SPEAKER RESONANCE VOICEBOX §

Box Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office action dated July 18, 2002, enclosed are the following regarding the above-identified patent application:

1. Amendment And Request for Reconsideration Under 37 CFR §1.111;
2. Return postcard; and
3. Transmittal letter (in duplicate).

[ ] Small entity status of this application has been established by a previously submitted verified statement under 37 C.F.R. §§ 1.9 and 1.27.

[ ] No additional fee is required.

The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	SMALL ENTITY			OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE	OR	RATE	ADDIT. FEE
TOTAL	24	minus	24	= 0	x 9	$_____	OR	x 18	$_____
INDEP	3	minus	3	= 0	x 42	$_____	OR	x 84	$_____
[ ]	FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				+ 140	$_____	OR	+ 280	$_____
					TOTAL	$_____	OR	TOTAL	$ 0.00

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.
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The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

[ ] Please charge Deposit Account No. [08-1394 H&B] in the amount of $_____.
[ ] A check in the amount of $ _____ is attached.
[X] The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. [08-1394 H&B].

[X] Any additional filing fees under 37 C.F.R. § 1.16 for the presentation of extra claims.
[ ] Any patent application processing fees under 37 C.F.R. § 1.17.
[X] A copy of this sheet is enclosed.

Respectfully submitted,

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